REMARKS

In response to the Office Action mailed on 2nd September, 2004, Applicant wishes to enter the following remarks for the Examiner's consideration. Applicant has amended claims 1, 8, 20, 21 and 37-39. Applicant has cancelled claim 30. Claims 1-29 and 31-40 are pending in the application.

Rejection of claims under 35 USC §112

Claims 8 and 37 have been rejected under 35 USC §112 for not identifying the product associated with the trademark JAVA. The claims have been amended to move the trademark ENTERPRISE JAVA BEAN™ . An Enterprise Java Bean is a computer program that conforms to a software component specification for allows distributed applications to be run on a network. In particular, the Enterprise Java Bean specification describes a server-side component architecture for the development and deployment of robust, component-based distributed applications using the JAVA™ programming language of Sun Microsystems. Claims 8 and 37 have been amended accordingly.

Allowance of claims 8 and 37 is therefore respectfully requested at the Examiner's earliest convenience

Rejection of claims under 35 USC §103(a)

Claims 1-4, 7-9, 14-33 and 36-40 have been rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,385,552 to Snyder in view of

U.S. Patent No. 6,308,326 to Murphy et al. Applicant respectfully traverses this rejection of the claims.

There is no prima facie motivation to combine the Snyder and Murphy references. The Snyder reference describes a method for collecting test measurements, while Murphy describes the use of run-time modules to adjust the operation of a state machine. Both references make use of a computer, but this alone in not sufficient reason to combine them. Snyder does not use a state machine and Murphy is not concerned with test measurements.

The Examiner acknowledges that the Snyder reference fails to teach, disclose or suggest the provision of a user-generated function or software module as called for in independent claims 1 and 21, and relies upon the teachings of Murphy et al. to overcome this defect. However, neither the Murphy reference nor the Snyder reference nor a combination teach the insertion of a variation point in a computer program at which control is passed to a user-generated process modification software module. The Murphy reference teaches that the passing of control to a CMI (code module interface) is initiated by the operating state of the software (column 2, lines26-29), rather than by the explicit inclusion of one or more variation points (actual instructions) in the control program. The Snyder reference teaches the selection of predefined tests via a menu. In claims 1 and 21, control is passed to a user-defined function when a variation point is reached. In Snyder, control is passed to a menu program. Even if one were to combine Snyder with Murphy, the result would be a method in which control is passed to a user-generated menu or a method in which control is passed to a menu to allow the user to select a user-generated module. Neither alternative is

equivalent to the recitations of claim 1 or 21, since neither claim 1 nor claim 21 uses a menu. This is an important distinction since the use of menu requires user intervention during the measurement process. For example, if a measurement process is to be repeated many times with the same variation, (as for example the testing of a number of samples of a new device) the Snyder system would require user intervention each time the process in operated. In contrast, in claim 1 and claim 21 the same user-defined function could be called every time the corresponding variation point is reached. Combining Murphy with Snyder does not cure this defect.

Claim 1 has been amended to more clearly define the variation point as a point in computer program at which a function call instruction is inserted by the designer of the program to pass control to a user-defined variation function. This amendment is support by the specification on page 8, lines 20-24 and page 9, lines 15-22, for example. In the Snyder reference, a call is made to a menu function rather than to a user-defined variation function that is generated by the user. Combining Murphy with Snyder does not cure this defect, since the menu function in Murphy is used select a user-defined CMI. Murphy column 7, lines 66-67 describes how a menu routine is used to select which CMI's are activated. However, these CMI's are not called from variation points in a program. Rather, the CMI's are activated by state changes. Murphy's approach allows the user to define CMI's to be applied at any state change, while the present invention allows user-defined functions to be called only at specific variation points in the code as determined by the designer. In Murphy there are no instructions inserted by the designer to call an interface to a user-defined function.

In claim 1, as amended, the association of the variation function with the interface is performed before the measurement process is executed. This amendment is supported by Figures 2 and 4 of the specification and the corresponding descriptions (see for example page 14, line 19 to page 15, line 3). This is in contrast with Snyder, since in Snyder it is not known what selection the user will make from the menu until after the menu is called. Thus, the selection of a function from a menu of functions cannot be considered equivalent to the associating element of the claims.

Claim 21 has been amended similarly. The recitations of claim 21 make clear that when the variation point is reached a function call passes control to a user-defined (and user-generated) variation function. This is in contrast to Snyder, in which control is passed to a menu. It is also in contrast to Murphy where the menu function is used to select CMI's. Claim 21 has also been amended to make clear that the association of the user-defined variation with the function call occurs prior to the execution of the measurement process. This is again in contrast to Snyder, where variations are not selected until the user interacts with a menu.

It can be seen in light of the foregoing discussion that even if one were to combine the Murphy reference with Snyder, the result would not be the claimed invention of claims 1 and 21.

In light of the foregoing remarks, Applicant respectfully submits that the Snyder and Murphy references, whether considered alone or in combination fail to teach, disclose, suggest or otherwise render obvious the recitations of claims 1 and 21. Applicant thus respectfully requests that this basis of

rejection of the claim be withdrawn and that a Notice of Allowance for claims 1 and 21 be mailed at the Examiner's earliest convenience.

Claims 2-20 depend from claim 1 and claims 22-40 depend from claim 21. Although additional arguments could be made for the patentability of each of the claims, such arguments are believed unnecessary in view of the above discussion.

In light of the foregoing amendments and explanations, applicant submits that all rejections of claims 1-29 and 31-40 have been overcome. The scope of the amended claim 1 is substantially the same with implicit meaning now made explicit. Allowance of claims 1-29 and 31-40 is therefore respectfully requested at the Examiner's earliest convenience. The undersigned wishes to make it clear that not making such arguments at this time should not be construed as a concession or admission to any statement in the Office Action.

Please contact the undersigned if you have any questions regarding this application.

Respectfully submitted,

Renee' Michelle Leveque

Larson & Associates, P.C.
Reg. No. 36,193
221 East Church Street
Frederick, Maryland 21701
301-668-3073
Attorney for Applicant(s)